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RESPONSE UNDER 37 CFR 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2176  
Docket No.: 826.1610

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Koji TSUKAMOTO

Serial No. 09/594,029

Group Art Unit: 2176

Confirmation No. 9256

Filed: June 15, 2000

Examiner: Nguyen BA, Paul H.

For: APPARATUS FOR RETRIEVING INFORMATION USING REFERENCE REASON OF  
DOCUMENT

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attention: **BOX AF**

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AUG 26 2004

Technology Center 2100

Sir:

This is in response to the Office Action mailed May 25, 2004, and having a period for response set to expire on August 25, 2004. In the Office Action, the Examiner noted that claims 1-18 are pending and rejected all of the claims as anticipated by U.S. Patent 6,233,571 to Egger et al. as in the January 17, 2004 Office Action. The only changes from the previous Office Action found in the claim rejections are the result of the changes to the claims in the Amendment filed by certificate of mail on March 17, 2004; specifically, adding "of a referring document" (page 3, lines 4 and 13) and "category of" (page 3, lines 12 and 18) and similar changes on pages 5 and 6. Also, the first line after the heading "Independent Claim 10" on page 6 is new.

In the Response to Arguments on pages 8-9 of the Office Action, the Examiner summarized the arguments in the March 17, 2004 Amendment and asserted that Egger et al.

teaches ... using categorical reasons (i.e. "comments")  
extensively to assist the user in understanding the data and the

relationships of the data the user is viewing (see col. 40, lines 60-67 et seq.). Examples of categories of reasons taught in Egger et al. include "overruled by," "criticizes," "distinguishes," and etc. (col. 41, lines 9-16; see also Figs. 10A and 10B). Furthermore, Egger et al. teaches the method of categorizing cited documents by analyzing the reason why particular documents are cited (i.e. "similar," "cases in," or "cases after" → see Figs. 5B-H)

(Office Action, page 8, lines 12-18).

As stated in the preceding quotation from the May 25, 2004 Office Action, the information provided by Egger et al. is used "to assist the user" (Office Action; page 8, line 13), and is not "information extracted by the reference position extracting device" (e.g., claim 1, lines 6-7) that is used by "an identification device analyzing the information extracted" (e.g., claim 1, line 6). Egger et al. teaches that the "researcher can ... identify the type of search to be performed ... by selecting the appropriate search in the Analysis box" (column 35, lines 22-24) from among the terms "similar", "cases in" and "cases after" cited in the Office Action. What happens when a user selects each of these terms is described in columns 28-34. However, the Office Action did not explain how this description relates to the claims.

It is noted that column 2, line 4 of Egger et al. includes the statement "[a]side from the inefficiency of Boolean searches, the present systems for computerized searching of data are inadequate to serve the needs of researcher for several other reasons" (column 2, lines 1-4). This is the only occurrence of any form of the word "reason" in Egger et al. It is submitted that one of ordinary skill in the art would not be taught, or even find a suggestion of, a reference reason identifying apparatus or method in which the operations recited in the claims are performed.

For the above reasons and the reasons set forth in the Amendment filed by certificate of mail on March 17, 2004, it is submitted that claim 1, 4, 5, 10 and 12-18 and claims 2, 3, 6-8 and 11 which depend therefrom, patentably distinguish over Egger et al.

### **Summary**

It is submitted that Egger et al. does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-18 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/594,029

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

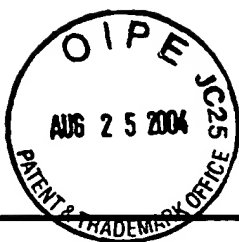
Respectfully submitted,

STAAS & HALSEY LLP

Date: 8/25/04

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AT 61

S&amp;H Form: (10/03)

<b>REPLY/AMENDMENT FEE TRANSMITTAL</b>	Attorney Docket No.	826.1610	
	Application Number	09/594,029	
	Filing Date	June 15, 2000	
	First Named Inventor	Koji TSUKAMOTO	
	Group Art Unit	2176	
AMOUNT ENCLOSED	0.00	Examiner Name	Nguyen BA, Paul H.

FEE CALCULATION (fees effective 10/01/03)					
CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	18	- 20 =	0	X \$ 18.00 =	\$ 0.00
INDEPENDENT CLAIMS	11	- 11 =	0	X \$ 86.00 =	0.00
Since an Official Action set an <u>original</u> due date of <u>August 25, 2004</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$420); 3 months (\$950); 4					
If Notice of Appeal is enclosed, add (\$330.00)					
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110.00)					
Information Disclosure Statement (Rule 1.17(p)) (\$180.00)					
Total of above Calculations =					\$ 0.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					
TOTAL FEES DUE =					\$ 0.00

- (1) If entry (1) is less than entry (2), entry (3) is "0".  
(2) If entry (2) is less than 20, change entry (2) to "20".  
(4) If entry (4) is less than entry (5), entry (6) is "0".  
(5) If entry (5) is less than 3, change entry (5) to "3".

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<input checked="" type="checkbox"/> The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.	

SUBMITTED BY: STAAS & HALSEY LLP			
Typed Name	Richard A. Gollhofer	Reg. No.	31,106
Signature	<i>Richard A. Gollhofer</i>	Date	8/25/04